

REMARKS

The Official Action mailed May 30, 2003, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time.

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on November 23, 1999, April 2, 2001, and July 12, 2002.

The Applicants note the *partial* consideration of the Information Disclosure Statement (IDS) filed on October 5, 1999. Specifically, it appears that the Examiner overlooked the citation of the C.S. McCormick et al. article. The Applicant respectfully requests that the Examiner provide an initialed copy of the Form PTO-1449 submitted October 5, 1999, evidencing consideration of the IDS.

A further IDS is submitted herewith and careful review and consideration of this IDS is requested.

Claims 14-16, 18, 19, 31-36, 39, 40, 43, 44, 48-50 and 52-57 are now pending in the present application, of which claims 14-16, 18 and 19 are independent. The independent claims have been amended to better recite the features of the present invention. Claims 15, 31-34, 36, 39, 40, 43, 44 and 50 have been amended to correct minor typographical and grammatical errors. For the reasons set forth in detail below, are believed to be in condition for allowance. Favorable reconsideration is requested.

The Official Action rejects claims 14-16, 18, 19, 31-36, 39, 40, 43, 44, 48-50 and 52-57 as obvious based on the combination of JP 09-312260 to Hamatani et al., U.S. Patent No. 5,236,850 to Zhang, and U.S. Patent No. 5,476,810 to Curran. The Official Action also relies on U.S. Patent No. 6,077,731 to Yamazaki et al. and asserts that it is equivalent to Hamatani. The Applicant respectfully submits that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present invention, as amended.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or

motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The prior art, either alone or in combination, does not teach or suggest all the features of the independent claims, as amended. Independent claims 14-16, 18 and 19 have been amended to recite a gate insulating film comprising a benzocyclobutene (BCB) film, which is supported in the specification at page 13, line 20. Hamatani, Yamazaki '731, Zhang and Curran do not teach or suggest at least the above-referenced feature of the present invention. Since Hamatani, Yamazaki '731, Zhang and Curran do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,



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